

#19

IN THE UNITED STATE PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Connolly, *et al.*

Serial No.: 09/701,739

Filed: Dec. 4, 2000

For: A Therapeutic Bed

Commissioner for Patents
Washington, D.C. 20231

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Examiner: Trettel, Michael

Group Art Unit: 3673

Attorney Docket No.: ROT.503

FAX RECEIVED

JUN 16 2003

PETITIONS OFFICE

**PETITION UNDER 37 C.F.R. § 1.47 TO ACCEPT INVENTORSHIP DECLARATION
OR UNDER 37 CFR 1.183 TO SUSPEND OR WAIVE THE REQUIREMENT OF A
SUPPLEMENTAL DECLARATION UNDER 37 CFR 1.67.**

Kinetic Concepts, Inc., the Assignee, petitions the Patent and Trademark Office to accept the inventorship declaration of Mrs. Una Connolly, filed on July 16, 2002, on behalf of co-inventor Chinnathamby Vijayendran. In the alternative, Kinetic Concepts moves to suspend the requirement of a supplemental declaration.

The file history of this patent application already includes signed declarations, filed on June 28, 2001, from both the executrix of Mr. Patrick Connolly's estate and Mr. Chinnathamby Vijayendran. On May 8, 2002, a preliminary amendment was filed adding priority claims to PCT/IE96/00087 filed Dec. 17, 1996; and Ireland application 950950, filed Dec. 18, 1995. The preliminary amendment presented additional claims "for matter originally shown or described but not substantially embraced in the statement of invention or claims originally presented." 37 C.F.R. § 1.67(b). Accordingly, efforts were made to obtain supplemental declarations from Una Connolly and Chinnathamby Vijayendran. Efforts to obtain Una Connolly's supplemental signature were successful. Efforts to locate Mr. Vijayendran and obtain his supplemental signature, however, were not successful.

On July 16, 2002, a 37 CFR 1.47 petition to accept inventorship declaration was filed. But the Patent and Trademark Office, while charging Kinetic Concepts the petition fee, never ruled on the petition. On or about May 14, 2003, a call was made to the Examiner, Michael Trettel, requesting information on the status of that petition. He confirmed that the petition was never forwarded to the Petitions branch for consideration. Kinetic Concepts, Inc., hereby **withdraws that petition** in favor of the instant petition.

The Patent and Trademark Office is hereby requested to accept the supplemental declaration of Mrs. Una Connolly, which was made on behalf of her deceased husband, also on behalf of the joint inventor listed in the application, Mr. Chinnathamby Vijayendran. *See MPEP 409.03(a); see also the July 16, 2002, submission, which includes the supplemental declaration of Una Connolly.*

On April 30, 2002, a cover letter soliciting a supplemental declaration, accompanied by a copy of the preliminary amendment, was mailed via Federal Express to Mr. Vijayendran's last known address (577 Stoney Stanton Road, Coventry, Great Britain CV6 SED). No response was received. During the first two weeks of June, 2002, unsuccessful attempts were made to locate Mr. Vijayendran's address and phone number using Internet directories for the United Kingdom. Also, contacts were made with KCI's Irish affiliate, KCI Medical, to verify Mr. Vijayendran's last known address and phone number. On July 2, 2002, attempts were made to reach Mr. Vijayendran through his last known phone number (+ 44 1203 666606), but these too were unsuccessful. *See Declaration in Support of 37 CFR 1.47 Petition*, at ¶¶ 3-6.

On April 21, 2003, a second attempt was made, via Federal Express, to reach Mr. Vijayendran at his last known address. The letter asked Mr. Vijayendran to respond by May 30, 2003. Federal Express's online tracking system indicates that the package was delivered on

April 24, 2003. But again, no response has been received. *See Declaration in Support of 37 CFR 1.47 Petition*, at ¶¶ 7-8.

The above-referenced invention and all patent rights associated therewith were assigned by the named inventors to Alliance Investments Limited, and then to KCI Licensing, Inc., as recorded at reel/frame nos. 012504/0751 and 012848/0100, respectively.

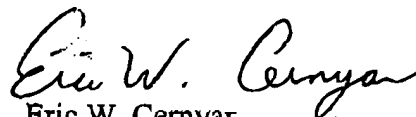
If the petition is not allowed, KCI would be irreparably damaged. KCI sought Mr. Vijayendran's supplemental declaration to support claims that were added via preliminary amendment that are entitled to a priority date (to Ireland Application No. 950950 filed December 18, 1995) that predates references cited in the Examiner's March 24, 2003, Office Action. *See 37 C.F.R. § 1.67.*

Alternative Petition Under 37 CFR 1.183

MPEP 603 states that "[w]hen an inventor who executed the original declaration is refusing or cannot be found to execute a required supplemental declaration, it is possible that the supplement may be suspended or waived in accordance with 37 CFR 1.183." Such a waiver or exemption is particularly appropriate here, because the added claims for which 37 CFR § 1.67 necessitates Mr. Vijayendran's supplemental declaration are based entirely on subject matter first presented in Irish Application No. 950950, for which Mr. Patrick Connolly was the sole inventor. In fact, Mr. Vijayendran's supplemental declaration would not even be necessary if claims 1-22 were cancelled so that Mr. Vijayendran could be deleted as an inventor. Such procedural acrobatics should not be required.

Applicant respectfully requests that any questions regarding this matter be directed to the undersigned attorney.

Respectfully submitted,



Eric W. Cernyar

Reg. No. 45,919

Kinetic Concepts, Inc.

P.O. Box 659508

San Antonio, TX 78265-9508

(210) 863-0063

(210) 255-4440 (fax)

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§ Examiner: Trettel, Michael

§ Group Art Unit: 3673

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DECLARATION IN SUPPORT OF 37 CFR 1.47 PETITION

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon, declares as follows:

1. I am over the age of eighteen and am competent to make this Declaration. The following statements are true statements made of my own knowledge or statements that I, on information and belief, believe to be true.

2. I am a registered patent attorney working for Kinetic Concepts, Inc., of San Antonio, Texas.

3. On or about April 30, 2002, I prepared the cover letter attached as Exhibit "A" to Mr. Chinnathamby Vijayendran for William Quirk's signature and procured a copy of the specification, claims, and preliminary amendment, to accompany the cover letter, for his review. I directed William Quirk's secretary to mail the cover letter and attachments to Mr. Vijayendran at his last known address. The package was mailed to Mr. Vijayendran at 577 Stoney Stanton Road, Coventry, Great Britain CV6 5ED, but no response was ever received from Mr. Vijaycndran. Inadvertently, no record was retained of the tracking number for the package.

4. During the first two weeks of June, 2002, I made unsuccessful attempts to locate Mr. Vijayendran's address and phone number using Internet directories for the United Kingdom.

5. In the first two weeks of June, I also contacted Brenda Whitbread of KCI Medical (based in Great Britain) and verified Mr. Vijayendran's last known address and phone number.

6. On July 2, 2002, I made several attempts were made to reach Mr. Vijayendran through his last known phone number (+ 44 1203 666606), but these too were unsuccessful.

7. On April 21, 2003, I made a second attempt to reach Mr. Vijayendran at his last known address via Federal Express. The letter, a copy of which is attached as Exhibit "B", asked Mr. Vijayendran to respond by May 30, 2003.

8. A copy of Federal Express's online tracking system's report for the mailing is attached as Exhibit "C." It indicates that the package was delivered on April 24, 2003. But again, no response has been received.

Executed on 16th day of June, 2003.

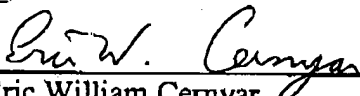

Eric William Cernyar
Reg. No. 45,919
10401 Fox Hollow
San Antonio, TX 78217
(210) 863-0063

EXHIBIT "A"



30 April 2002

Chinnathamby Vijayendran
577 Stoney Stanton Road
Coventry, Great Britain CV6 5ED

Dear Mr. Vijayendran:

We are delighted by your's and the late Mr. Connolly's ingenuity in developing therapeutic hospital beds. As you probably know, KCI's affiliates own a number of those patent applications that are still pending, including United States application number 09/701,739. On June 6, 2001, you helpfully signed a declaration and power of attorney with regard to this application.

We recently took over direct responsibility for prosecuting the application. Upon review of the application, we determined that it should be amended to claim priority to an earlier patent application by the late Mr. Connolly. This amendment will enable KCI to claim an earlier filing date for an important portion of the patent application.

In order to file this amendment, United States regulations require that the inventors sign a new or supplemental declaration. We have prepared just such a declaration, which is enclosed. If you could be so kind, please sign the enclosed declaration and return it to me at the following address:

Will Quirk
c/o Eric W. Cernyar
Legal Department
Kinetic Concepts, Inc.
4958 Stout Drive
San Antonio, Texas, USA 78219-4334

If you would like, you can mail it to us via FedEx, using their International Air Waybill form. Our FedEx account number is 2316-5634-0, which you can enter under the "8a. Payment *Bill transportation charges to:*" and "8b. Payment *Bill duties and taxes to:*" fields on the right-hand side of the Waybill. Make sure to check the box next to "recipient" in those fields, so that we cover the shipping charges. Please also check the "FedEx Int'l Priority" box in field 5, and the "This shipment does not contain Dangerous Goods" box in field 7. Please also sign and date the Waybill at Field 9.

As you will notice, the declaration states that you have reviewed and understood the contents of the specification and claims, as amended. Accordingly, we have also enclosed a copy of the specification, claims, and the amendments we propose to make to them. In summary, the amendments describe the "invention" as a therapeutic hospital bed that uses a motor to rotate it from a patient face-up (or supine) position to a patient face-down (or prone) position, and that includes one or more of the following:

Mailing:
P.O. Box 859508
San Antonio, Texas 78265-9508
1-800-531-5396 / Fax (210) 255-6998

Corporate:
8023 Vantage Drive
San Antonio, Texas 78230-4726
(210) 524-9000

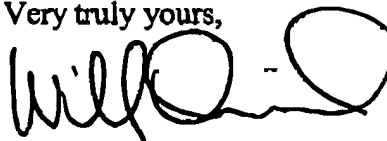
Manufacturing:
4958 Stout Drive
San Antonio, Texas 78219-4334
(210) 662-9191

a plurality of cushions or other supports to support the patient in a prone position;
a pair of side rails extending upwardly from the patient support platform; and
a hinged section that provides access to the back of the patient.

Two claims are also directed to methods for treating patients with respiratory problems such as adult respiratory distress syndrome using kinetic therapy in the prone position.

Because the patent application is already pending, KCI has an urgent need to file the attached amendment, and your supplemental declaration, as quickly as possible. Please review the enclosed materials and sign and date the enclosed declaration by May 31, 2002. We are very grateful for your assistance in this matter. If you have any questions, please do not hesitate to contact me.

Very truly yours,

A handwritten signature in black ink, appearing to read "Will Quirk", with a large, stylized loop at the end.

Will Quirk, Vice President
KCI Licensing, Inc.

EXHIBIT “B”



21 April 2003

Chinnathamby Vijayendran
577 Stoney Stanton Road
Coventry, Great Britain CV6 5ED

838778671550

Dear Mr. Vijayendran:

We are delighted by your's and the late Mr. Connolly's ingenuity in developing therapeutic hospital beds. As you probably know, KCI's affiliates own a number of those patent applications that are still pending, including United States application number 09/701,739. On June 6, 2001, you helpfully signed a declaration and power of attorney with regard to this application.

We recently took over direct responsibility for prosecuting the application. Upon review of the application, we determined that it should be amended to claim priority to an earlier patent application by the late Mr. Connolly. This amendment will enable KCI to claim an earlier filing date for an important portion of the patent application.

In order to file this amendment, United States regulations require that the inventors sign a new or supplemental declaration. We have prepared just such a declaration, which is enclosed. If you could be so kind, please sign the enclosed declaration and return it to me in the enclosed FedEx Express Envelope with attached FedEx Waybill. Of course, we will accept all the shipping charges.

As you will notice, the declaration states that you have reviewed and understood the contents of the specification and claims, as amended. Accordingly, we have also enclosed a copy of the specification, claims, and the amendments we propose to make to them. In summary, the amendments describe the "invention" as a therapeutic hospital bed that uses a motor to rotate it from a patient face-up (or supine) position to a patient face-down (or prone) position, and that includes one or more of the following:

a plurality of cushions or other supports to support the patient in a prone position;
a pair of side rails extending upwardly from the patient support platform; and
a hinged section that provides access to the back of the patient.

Two claims are also directed to methods for treating patients with respiratory problems such as adult respiratory distress syndrome using kinetic therapy in the prone position.

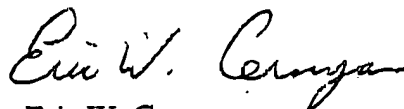
Because the patent application is already pending, KCI has an urgent need to file the attached amendment, and your supplemental declaration, as quickly as possible. Please review the enclosed materials and sign and date the enclosed declaration by May 31, 2003. We are very grateful for your assistance in this matter. If you have any questions, please do not hesitate to contact me.

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8023 Vantage Drive
San Antonio, Texas 78230-4726
(210) 524-9000

Manufacturing:
4958 Stout Drive
San Antonio, Texas 78219-4334
(210) 882-9191

Very truly yours,

A handwritten signature in cursive script, reading "Eric W. Cernyar".

Eric W. Cernyar
Kinetic Concepts, Inc.

EXHIBIT “C”

Cernyar, Eric

S nt: Monday, May 05, 2003 9:00 AM
Subject: Online FedEx Tracking - 838778671550

Attached is proof of attempted delivery of documents to Mr. Chinnathamby Vijayendran at his last known address.

Tracking Number : 838778671550
Reference Number : ROT. 503.US
Ship Date : 04/21/2003
Delivered To : Recipient
Delivery Location : COVENTRY GB
Delivery Date/Time : 04/24/2003 09:13
Signed For By : .VIJAYENDRAN
Service Type : Priority Envelope

Scan Activity	Date/Time	Scan Exceptions
Delivered/ COVENTRY GB	04/24/2003 09:13	
On FedEx vehicle for delivery/ BIRMINGHAM GB	04/24/2003 07:38	
Package status/ BIRMINGHAM GB location	04/23/2003 20:35	Package in FedEx
Delivery attempt/ COVENTRY GB available or Business closed	04/23/2003 08:44	Customer not
On FedEx vehicle for delivery/ BIRMINGHAM GB	04/23/2003 07:34	
Arrived at FedEx Destination Location/ BIRMINGHAM GB	04/23/2003 05:53	
Package status/ STANSTED GB destination country	04/23/2003 00:51	In transit in
Left FedEx Ramp/ STANSTED GB	04/23/2003 00:50	
Package status/ STANSTED GB Delivery	04/22/2003 19:12	Released for
Package status/ STANSTED GB for clearance	04/22/2003 19:12	Package available
Arrived at FedEx Ramp/ STANSTED GB	04/22/2003 19:12	
Left FedEx Sort Facility/ MEMPHIS TN	04/22/2003 03:58	
Left FedEx Sort Facility/ MEMPHIS TN	04/22/2003 01:26	

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FedEx has not validated the authenticity of any email address.